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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,799	12/01/2003	Thomas Hanna	2002P16048US	5524

7590 07/18/2007  
SIEMENS CORPORATION  
INTELLECTUAL PROPERTY DEPT.  
170 WOOD AVENUE SOUTH  
ISELIN, NJ 08830

EXAMINER
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WHIPPLE, BRIAN P

ART UNIT	PAPER NUMBER
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2152

MAIL DATE	DELIVERY MODE
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07/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/724,799

**Applicant(s)**

HANNA ET AL.

**Examiner**

Brian P. Whipple

**Art Unit**

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/26/04</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-20 are pending in this application and presented for examination.
2. The preliminary amendment entered on the date of filing has been entered and made of record.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. As to claim 1, the meaning of the phrase "monitoring instant" is unclear. It appears the applicant is defining a monitoring instant as a system, but the use of "instant" would imply a point in time as opposed to a system. The examiner will treat the "monitoring instant" as a system for the purposes of examination.

Additionally, the meaning of the phrase "a list... can be accessed..." is unclear. The sentence appears to be missing a word, as was previously satisfied by the use of the word "which" prior to preliminary amendment. The examiner will interpret the phrase as "a list... that can be accessed..." for the purposes of examination.

Finally, the meaning of the phrase "the monitoring being carried out on the basis of the characteristic" is unclear. It appears the sentence should read, "the monitoring is being carried out..." or there should be more words at the end of the sentence describing what the monitoring is doing on the basis of the characteristic.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-4, 6-10, and 14-20 are rejected under 35 U.S.C. 102(a/e) as being anticipated by McDowell et al. (McDowell), U.S. Publication No. 2002/0035605 A1.

8. As to claim 1, McDowell discloses a method for monitoring an application in a packet-switching network (Abstract, ln. 1-4; [0050], ln. 5-8), comprising:  
recording a state of the application by a monitoring instant ([0052], *especially* ln. 7-10 and 14-16);

transmitting the state to a Presence Application which indicates the state ([0049], *especially* ln. 6-8; [0052], *especially* ln. 1-2 and 7-10);

registering the application by the monitoring instant as a first communication partner in a list of communication partners can be accessed in the network ([0049], ln. 6 – [0050], ln. 5; [0051]; [0052], ln. 7-16);

registering the Presence Application in the list as a second communication partner which monitors the first communication partner ([0049], ln. 6 – [0050], ln. 5; [0051]; [0052], ln. 1-2 and 7-16; *especially* [0052], ln. 1-2, “The Presence Server... power[s] the buddy list.”);

transmitting the state of the application to the Presence Application as a characteristic which is associated with the first communication partner ([0052], ln. 7-16), wherein the monitoring being carried out on the basis of the characteristic ([0052], ln. 7-16).

9. As to claim 2, McDowell discloses control instructions for controlling the application are transmitted from the Presence Application to the monitoring instant ([0056], ln. 4-7 and 13-15; instructions regarding other users presence are transmitted to the client in order to control how the status of the other users on the client’s buddy list presented to the client).

10. As to claims 3 and 8, McDowell discloses a presence/instant messaging system is used for monitoring instants ([0056], ln. 4-7).

11. As to claims 4 and 9-10, McDowell discloses the transmission of the state is secured by a handshake process ([0081], ln. 5-7; [0139]; TCP/IP is known in the art to include a handshake process).

12. As to claims 6 and 14-17, McDowell discloses an application can be monitored by any desired number of Presence Applications (Fig. 7; [0049], ln. 6-8), and Presence Applications can monitor any desired number of applications ([0051]; [0056], ln. 4-7).

13. As to claims 7 and 18-20, McDowell discloses the monitoring instant which is associated with an application to be monitored is found and registered on the basis of the request of the Presence Application ([0056]; [0096]).

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 5 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDowell as applied to claims 1-4 above, in view of IETF; 2.1.12 SIP for Instant Messaging and Presence Leveraging (simple); 7/31/01.

16. As to claims 5 and 11-13, McDowell discloses the invention substantially as in parent claim 2, including the registration of the application and the transmission of the state are carried out using an SIP infrastructure ([0139], ln. 6-12), but is silent on the SIMPLE extension to the SIP protocol.

However, IETF discloses the SIMPLE extension to the SIP protocol (Pg. 1, heading).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of McDowell by expanding on the use of SIP to include the SIMPLE extension as the motivations for using both are to make use of an interoperable standard.

SIMPLE extends SIP to instant messaging and presence leveraging. As McDowell is directed to presence detection and instant messaging and discloses the use of SIP, the incorporation of SIMPLE is an obvious one in order to make use of a suite of services for instant messaging and presence through an interoperable standard (**Description of Working Group, ¶ 1**).

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the Notice of References Cited (PTO-892).

Art Unit: 2152

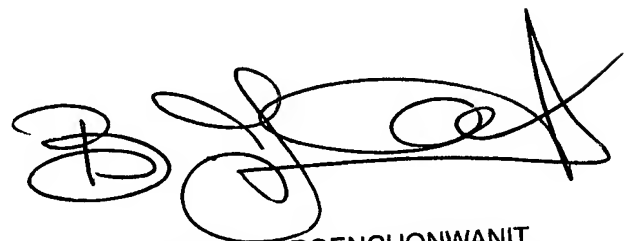
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Whipple whose telephone number is (571) 270-1244. The examiner can normally be reached on Mon-Fri (8:30 AM to 5:00 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BPW

Brian P. Whipple  
7/9/07

  
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SUPERVISORY PATENT EXAMINER  
7/12/7